REMARKS

In order to expedite the prosecution of the present application, Claims 3, 12 and 18 have been amended in order to more particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically speaking, "nitrate" in Claim 3 has been amended to "nitric acid". Support for this amendment can be found in the first full paragraph on page 20 of the specification. Claim 12 has been amended to state that the at least one metal material is contacted with a solution after electrolytic treatment in the treating solution in order to avoid possible confusion between the "treating solutions". Claim 18 defines a treating solution in "closed" language that restricts the composition of the treating solution to the listed component. No new matter has been added.

Claims 3-7, 10, 13-15 and 18 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over Claims 1-18 of application Serial No. 10/480 841. Claims 8, 9, 11, 12, 16 and 17 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting over Claims 1-18 of copending application Serial No. 10/480 841 in view of Bittner et al. However, the currently presented claims expressly exclude magnesium therefrom and patentably distinguish the presently claimed invention over the claims of U.S. application Serial No. 10/480 841, alone, or in combination with Bittner et al. Accordingly, it is respectfully submitted that these grounds of rejection have been overcome.

Claims 3-7, 10, 14, 15 and 18 have been rejected under 35 USC 102(c) as being anticipated by Nakayama et al. Claims 16 and 17 have been rejected under 35 USC 103(a) as being unpatentable over Nakayama et al. Claims 3-5, 7, 10, 14-16 and 18 have been rejected under 35 USC 103(a) as being unpatentable over Kogure. Claim 6 has been rejected under 35 USC 103(a) as being unpatentable over Kogure in view of Frelin

et al. Claim 13 has been rejected under 35 USC 103(a) as being unpatentable over Kogure in view of Frelin and further in view of Bartik-Himmler et al. Claims 8, 9, 11, 12 and 17 have been rejected under 35 USC 103(a) as being unpatentable over Kogure in view of Bittner et al. Applicants respectfully traverse these grounds of rejection and urge reconsideration in light of the following comments.

The presently claimed invention is directed to an aqueous surface-treating solution capable of treating independently or collectively at least one metal material selected from the group consisting of a ferriferous material, a zinciferous material, an aluminiferous material and a magnesiferous material. The treating solution consists essentially of 5-5000 ppm of a zirconium compound, calculated as metal zirconium, 0.1 to 100 ppm of free fluorine ion, at least one compound selected from the group consisting of 5 to 100 ppm of a calcium compound, calculated as metal calcium, 10 to 5000 ppm of a strontium compound, calculated as metal strontium and, optionally, 1000 to 50000 ppm of a nitric acid group, at least one oxygen acid and/or salt of an oxygen acid selected from the group consisting of $HClO_3$, $HBrO_3$, HNO_2, HNO_3, $HMnO_4$, HVO_3, H_2O_2, H_2WO_4, H_2MoO_4 and salts thereof, at least one polymer compound selected from the group consisting of water-soluble compounds and water-dispersible polymer compounds and at least one surface-active agent selected from the group consisting of a nonionic surface-active agent, an anionic surface-active agent and a cationic surface-active agent, and having a pH of 2 to 6. No new matter has been added.

As explained in the previous Response, the present invention provides a surface-treating solution which can form a surface-treated film having an excellent corrosion resistance on the surface of a ferriferous material, zinciferous material, aluminiferous material and a magnesiferous material, either individually or collectively, does not contain a harmful component to the environment and does not generate a sludge that has to be disposed of.

Additionally, with the surface-treating solution of the present invention, surface conditioning of the metal material to be treated is not required, which shortens the treatment time and reduces the space needed for treatment. It is respectfully submitted that the currently claimed invention clearly is patentably distinguishable over the prior art cited by the Examiner.

The Nakayama et al publication is directed to a composition for the surface treatment of a metal containing iron and/or zinc which comprises a compound containing at least one metal element selected from the group consisting of titanium, zirconium, hafnium and silicon and a compound containing fluorine as a supplying source of hydrogen fluoride. Additionally, a compound containing at least one metal element selected from the group consisting of silver, aluminum, copper, iron, manganese, magnesium, nickel, cobalt and zinc can be present. Example 7 of this reference has been cited as disclosing a treatment solution that falls within the claimed component concentration and pH ranges. However, the currently pending claims use "consisting essentially of" language to expressly exclude magnesium and titanium therefrom. As such, the Nakayama et al patent application clearly does not anticipate the currently presented claims under 35 USC 102(e).

With respect to the rejection of Claims 16 and 17 under 35 USC 103(a) over the Nakayama et al application, the Examiner has stated that it would have been obvious to vary the amount of surface treatment time during the process of Nakayama et al in order to produce desired coating thicknesses or coating weight. Applicants respectfully request that the Examiner provide substantiation for this statement other than his opinion. There is no showing in the Nakayama et al reference that varying the surface treatment time would result in a change in coating thickness or coating weight. As such, Applicants respectfully submit that hindsight provided by

Applicants' disclosure has motivated the Examiner to make this rejection.

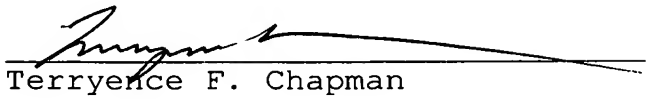
Applicants respectfully submit that the Nakayama et al application is not even available against the present application under any section of 35 USC 102. In order for the Nakayama et al application to be available as a reference under 35 USC 102(e), it must have a different inventive entity than that of the present application and it must have a U.S. filing date before the invention by the Applicant for patent. Since the U.S. filing date of Nakayama et al was July 19, 2004, this is clearly after Applicants' international filing date of December 11, 2003, let alone the priority date of December 13, 2002. If the Examiner is using the PCT filing date of June 12, 2002 as the U.S. filing date, it is required that the international application is published under PCT article 21(2) in English. This is not the case in the present application. As such, it is respectfully submitted that the Examiner's use of the Nakayama et al application as a reference under 35 USC 102 is in error.

The Kogure reference discloses a metal surface treatment liquid having a pH of less than 6 and containing oxytitanic ion and/or peroxytitanic ion therein. The currently presented claims expressly exclude titanium from being present in the treating solution. As such, it is respectfully submitted that the presently claimed invention clearly is patentably distinguishable over this reference.

Secondary references Frelin et al, Bartik-Himmler et al and Bittner have been cited by the Examiner to supplement Kogure in teaching various aspects of the presently claimed invention. However, given that the Kogure reference requires the use of titanium and the presently claimed invention expressly excludes titanium from being contained therein, the secondary references do not cure the deficiencies of the primary Kogure reference and, as such, do not patentably disclose the presently claimed invention.

Reconsideration of the present application and the passing of it to issue is respectfully solicited.

Respectfully submitted,



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